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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,580	07/11/2003	Thomas L. Foster	10922/51	3677
757	7590	09/25/2006	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			SAM, CHARLES H	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/617,580	Applicant(s) FOSTER ET AL.	
	Examiner Charles H. Sam	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/01/03</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-9, 12-19 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Que 6,325,807 in view of Holman et al. 6,152,944. Que discloses the invention as claimed except for a spiral cut. However, Holman discloses an embodiment having a spiral cut. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the Que device by adding the spiral cut in view of Holman to provide more flexibility to the device.

Regarding claims 2, 5, 6, 8, 13, 15, 16, 17 and 22 the pitch and width of the spiral cut, and the size and material of cannula are an obvious matter of design choice since applicant has not disclosed having this specific value is for any particular purpose or solves any stated problem.

Regarding claims 3, 4, 7, 12, 18, 19 and 24, Que discloses the grasping portion for engaging an object.

Regarding claim 9, note the Que reference column 1, lines 40-50.

Regarding claim 13, it is very well known in the art to use stainless steel to make the cannula to prevent rusting.

Regarding claims 14 and 26, note the Que reference.

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Regarding claim 27, the device of Que in view of Holman is inherently capable of performing the recited method steps.

2. Claims 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Que 6,325,807 in view of Holman et al. 6,152,944 as applied to claims 1 and 15 above, and further in view of Sirimanne et al. 6,136,014. Que in view of Holman et al. discloses the invention as claimed except for a cutting blade. However, Sirimanne discloses a tissue removing device comprising a cutting blade. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Que in view of Holman et al. by adding a cutting blade in view of Sirimanne for cutting the tissue.

3. Claims 10,12,20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Que 6,325,807 in view of Holman et al. 6,152,944 as applied to claims 1,15 and 27 above, and further in view of Dretler 4,927,426. Que in view of Holman et al. discloses the invention as claimed except for a laser fiber. However, Dretler discloses a kidney stone capturing device comprising an optical fiber 30 as shown in figures 5 and 6. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to further modify Que by including a laser fiber in view Dretler to provide means for transmitting light.

Regarding claim 28, the modified device of Que in view of Dretler is inherently capable of performing the recited method steps.

4. Claims 11 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Que 6,325,807 in view of Holman et al. 6,152,944 and Dretler 4,927,426 as applied

to claims 10 and 28 above, and further in view of Goodman 4,557,255. Que in view of Holman et al. and Goodman discloses the invention as claimed except for a ureteroscope. However, Goodman discloses as shown in figure 1-6 a ureteroscope 10 having irrigation channels 36,38 and eye piece 44. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to further modify The Que device by including a ureteroscope for viewing and irrigating the operation site.

Regarding claim 29, the modified Que device is inherently capable of performing the recited method steps.

### ***Response to the Applicant Arguments***

5. Applicant's arguments filed on 4/21/06 have been fully considered but they are not persuasive. The arguments with respect to the Que and Holman et al. references stating that they are non-analogous art and there is no suggestion to apply a spiral cut to the catheter are not true, because these two references are classified in the same class 606 and they are disclosed the surgical catheters and a spiral cut can be formed by spiral cutting a tubular member such as a sleeve or a catheter, therefore the rejections to the claims are appropriate.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H. Sam whose telephone number is (571) 272-4703. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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September 13, 2006

  
ANHTUAN T. NGUYEN  
SUPERVISORY PATENT EXAMINER  
9/13/06